

### REMARKS

Applicant's attorney thanks the Examiner for the courtesy of the telephone interview on January 15, 2009. Claim 1 and the Frank patent (U.S. Patent No. 7,117,199) were discussed, as well as possible claim amendments.

Claims 1-46 are pending for further examination.

#### Information Disclosure Statement (IDS)

The Office action states that the IDS of July 17, 2007 has been placed in the file, but not considered because the copy of pages from the mapquest.com web site were not sufficiently clear. Applicant submits with this response a clearer copy of the web site pages, together with a clean copy of the form-1449, and requests that the Examiner the submitted information and return an initialed copy of the form 1449 to the applicant.

#### Rejections under 35 U.S.C. § 112, par. 2.

The Office action rejected various claims as allegedly indefinite for lack of antecedent basis. Several claims (*e.g.*, 9, 23 and 35) have been amended to address the lack of antecedent basis. However, as explained below, applicant submits that the other claim features identified by the Office action have proper antecedent basis and that the claims satisfy the requirements of § 112, par. 2.

\* Claim 1: Applicant fails to see how the language "a request" and "information" in the phrase "receiving *a request* for *information* relating to a location on the form selected by a user" lacks antecedent basis. There is nothing unclear about this language and the Office action fails to elaborate.

\* Claim 2: Applicant fails to see how the language "a request" and "information" in the phrase "receiving *a request* for *information* relating to a second location on the form selected by

the user” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 7: Applicant fails to see how the language “information” in the phrase “pre-populated with *information* relating to the selected form location” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 9: Applicant has amended this claim to recite that “at least one of the hyperlinks provides access to pages created based on a search of information contained in the ideas.” Antecedent basis for the phrase “the ideas” appears in claim 5 (“retrieving, from a database, ideas . . .”), from which claim 9 indirectly depends. As to the language “information” in claim 9, applicant fails to see how this word lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 10: Applicant fails to see how the language “information” in the phrase “providing to the user *information* relating to the selected form location, . . .” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate. Regarding the phrase “the provided information,” the phrase “*providing* to the user *information* relating to the selected form location, . . .”, which appears earlier in the claim, provides proper antecedent basis.

\* Claim 11: Applicant fails to see how the language “an interactive depiction of a map” in the phrase “presenting *an interactive depiction of a map*” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate. Likewise, applicant fails to see how the language “a request” and “information” in the phrase “receiving *a request* for *information* relating to a selected geographic location on the map . . .” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 12: Applicant fails to see how the language “the information” in the phrase “*the information* relating to *the selected form location*” lacks antecedent basis. Claim 12 depends indirectly from claim 1, which recites “receiving a request for *information relating to a location on the form selected by a user.*” It is readily clear that the quoted phrase in claim 12 refers back

to the quoted language in claim 1. There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 13: Applicant fails to see how the language “the information” in the phrase “*the information* relating to the selected form location” lacks antecedent basis. Claim 13 depends indirectly from claim 1, which recites “receiving a request for *information relating to a location on the form selected* by a user.” It is readily clear that the quoted phrase in claim 13 refers back to the quoted language in claim 1. There is nothing unclear about this language and the Office fails to elaborate. Likewise, applicant fails to see how the language “the specified subject” lacks antecedent basis. Claim 13 itself previously recites “wherein the form relates to *a specified subject, . . .*” There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 14: Applicant fails to see how the language “a user selection” in the phrase “in response to receiving *a user selection*” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 15: Contrary to the assertion in the Office action, claim 15 does not recite the phrase “*the information.*” Regarding the language “the specified subject,” claim 15 itself clearly provides proper antecedent basis because the claim previously recites “wherein the form relates to *a specified subject, . . .*” There is nothing unclear about this language and the Office fails to elaborate.

\* Claim 16: Applicant fails to see how the language “information” in the phrase “wherein the interactive map depicts a plurality of countries about which *information* relating to the specified subject may be obtained” lacks antecedent basis. There is nothing unclear about this language and the Office fails to elaborate. Likewise, applicant fails to see how the language “a user” in the phrase “delivering to *a user . . .*” lacks antecedent basis. Again, there is nothing unclear about this language and the Office fails to elaborate.

Applicant has amended claims 23 and 35 in a manner similar to claim 9 to provide proper antecedent basis.

The remaining claims have been reviewed, but no other §112 issues have been identified.

Rejections under 35 U.S.C. §§102-103

The Office action rejects the claims over the following references:

(1) Claims 1-2, 4-11, 13-18, 20-26, 28-32, 34-41, 43-47, 50-54 and 57-61 are rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 7,117,199 (Frank).

(2) Claims 49, 56 and 63 are rejected under 35 U.S.C. §103(a) as unpatentable over the Frank patent

(3) Claims 3, 12, 19, 27, 33, 42, 48, 55 and 62 are rejected 35 U.S.C. §103(a) as unpatentable over the Frank patent in view of U.S. Patent Publication No. 2002/0052792 (Johnson).

Applicant respectfully requests reconsideration.

Claims 1, 17 and 32 have been amended to clarify that the word “form” refers to a document with one or more areas for insertion of information. Support for the amendments can be found, for example, at page 5, lines 6-8 of the specification.<sup>1</sup> Examples of such forms include, but are not limited to, tax, securities, insurance and banking forms (*see* page 6, lines 15-21).

One aspect of the invention relates to presenting an interactive graphical depiction of a form<sup>2</sup> through a computer network to allow a user to request information relating to a selected location on the form by interacting with the graphical depiction of the form. In response, information relating to the selected location on the form is delivered through the network.

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<sup>1</sup> Applicant notes that this is consistent with the ordinary meaning of the word “form” would be understood by a person of ordinary skill in view of the present application. *See, e.g.,* [www.merriam-webster.com/dictionary](http://www.merriam-webster.com/dictionary) (2008) which lists the following as a definition for the word “form”: “a printed or typed document with blank spaces for insertion of required or requested information <tax forms>.”

<sup>2</sup> Applicant notes that although a “form” refers to a document with one or more areas for insertion of information, this does not necessarily mean that information can be inserted into or onto the interactive, graphical depiction of the form.

The invention can facilitate, for example, a user's planning, regulatory compliance and research needs by allowing the user to select a particular part of the form about which the user desires information and, in response, to receive such information relating specifically to the selected part of the form.

The Frank patent discloses a computer system that presents a map interface that enables a user to pose a query that represents a spatial domain. The search criteria that define the query include a free text entry query and a domain identifier. The Frank patent discloses that the map interface can be graphical (col. 6, lines 10-13). Although the map interface can enable the user to input the domain identifier as part of the search criteria by interacting with the displayed map (col. 3, lines 46-51), the search query itself, however, is entered using text entry tools (col. 8, lines 42-43).

In contrast to the subject matter of independent claim 1, the Frank patent has absolutely nothing to do with a graphical depiction of a "form" as set forth above. Furthermore, the distinction between graphical depiction of a map and graphical depiction of a form is significant. For example, selecting a "location" on a map identifies a geographical location, which is very different from selecting a "location" on a form to identify a part of the form for which information is desired.

Also, the method of operation disclosed by the Frank patent is very different from the claimed method, which recites receiving a request for information relating to a location on the form selected by the user, "the selection and the request being made through interaction with the graphical depiction of the form" and "delivering information . . . in response to the request, wherein the delivered information includes at least one of [several categories] relating to the selected form location." An example is described at page 15 of the specification as follows:

To illustrate how the graphical, interactive system can work, it is assumed that a user clicks on the link associated with line 19 of the tax form in FIG. 7. A partial list of tax planning ideas that are

associated with line 19 of the tax form is displayed to the user on a display screen coupled to the user's device(see FIG. 8).

Thus, according to claim 1, in response to a user's submitting a request by selecting a location on the interactive depiction on the form, information about the selected location on the form is delivered.

In contrast, the Frank patent discloses that after a user has submitted the query, the map interface only displays icons to represent documents in storage that satisfy the query criteria (col. 8, line 66 – col. 9, line 2). The icons can be superimposed on the map to provide a correlation between the icon's documents and the corresponding domain location (col. 8, line 63 – col. 9, line 5). However, the user must subsequently select a particular icon to retrieve any of the actual information (*i.e.*, documents) represented by the icon. Thus, according to the Frank patent, the information is not delivered by interacting with the graphical depiction of the *map*; it is only when the user selects a particular *icon* that any of the underlying requested information is delivered.

At least for the foregoing reasons, claim 1, as well as its dependent claims, should be allowed.

Independent claims 17 and 32, as well as their respective dependent claims, should be allowed for similar reasons.

The claims depending from claims 1, 17 and 32 recite additional features that make those claims independently patentable.

For example, claim 2 recites receiving a request for information relating to a second selected location on the form and delivering additional information relating to the second selected location. Thus, claim 2 refers to delivering information about the *same* form as recited in claim 1. There is no disclosure of this feature in the Frank patent.

Likewise, the Frank patent says nothing about tax forms, as recited in claims 3, 12, 19, 27, 33 and 42. The Office action acknowledges this, but relies on the Johnson application for its

disclosure of software that associates geographical jurisdictions with respective tax information. According to the Johnson application, interactive windows in the form of a pop-up menu to facilitate user selections related to tax status. Such a tax assessment, remittance and collection system has nothing to do with Frank's system for spatial coding and display of information. A person of ordinary skill would have had no reason to modify the disclosure of the Frank patent in view of the Johnson application so as to obtain the subject matter of claims 3, 12, 19, 27, 33 and 42.

Furthermore, the combination of features in each of claims 11, 26 and 41, as well as their dependent claims, is not disclosed or rendered obvious by the cited references taken alone or together. These claims recite (1) delivering information based on a user's selection of a location on an interactive graphical depiction of a form and (2) delivering additional information based on the user's selection of a geographical location on an interactive depiction of a map. As already explained, although the Frank patent discloses interacting with a graphical depiction of a map, it says nothing about interacting with graphical depictions of forms (*i.e.*, documents with one or more areas for insertion of information) for delivery of information based on a selected location on the form.

Likewise, the cited references do not disclose or render obvious the subject matter of amended claims 13, 28 and 43 which recite that the information relating to the selected form location and the additional information relating to the selected geographic location comprise one or more sources of law relating to the specified subject, the sources of law including at least one of relevant statutes, regulations or legal decisions. Support for the amendments to these claims can be found, for example, at page 11, lines 17-21.

### Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or

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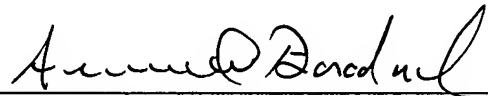
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other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Enclosed is a check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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